

REMARKS

The present amendment is in response to the Final Rejection dated August 25, 2004, where the Examiner rejected claims 19-31 and the second claim numbered 23, hereinafter referred to as claim 32. By the present amendment, the claim numbering has been corrected by renumbering the second claim numbered 23 as claim number 32. Additionally, the present amendment corrects the 112 rejection directed to claims 21 and 28 (note: it appears that the Examiner accidentally referred to claim 27 in the Office Action when, in fact, it appears the Examiner was referring to claim 28). Further still, the present amendments more distinctly claim the invention by modifying the preamble of the independent claims 19 and 26 to reflect that the invention is related to a *single communication device having a processor configured to perform hand off communications.*

A. Withdrawal of Finality of Rejection

In the Office Action dated August 25, 2004, the Examiner has ***finally rejected*** claims 19-32 pending in the present application on the basis of new ground(s) of rejection and newly cited art.

A good and sufficient reason why the present response is necessary and was not earlier presented is that an entirely new reference has been cited in the present final rejection dated August 25, 2004 (37 CFR 1.116(c)). The new reference is Aoki, et al. (USPN 5,535,430) (hereinafter “Aoki ‘430”) which is for the first time brought to applicant’s attention by means of the present ***final rejection*** dated August 25, 2004. The new reference, i.e., Aoki ‘430, was not

cited in the present application prior to the instant final rejection. Since Aoki '430 is a primary reference upon which the Examiner has now relied, applicant believes that it would be manifestly unfair for the Patent Office not to consider applicant's arguments which are necessitated due to the newly cited reference, Aoki '430 (37 CFR 1.116(c)), for considering applicant's present amendment and response and withdrawing the finality of the present Office Action.

B. Claim Objections

The Examiner identified the misnumbered claim 23 (the second one) and requested that the claim be renumbered 29. However, there was another claim that was already numbered 29. Due to this conflict in the numbering schemes, misnumbered claim 23 was renumbered claim 32.

C. Claim Rejection Under 35 U.S.C. 112, Second Paragraph

The Examiner has rejected claims 21 and 27 as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner states that claim 21 and 27 recite the limitation, "the second first antenna circuit" and there is insufficient antecedent basis for this limitation.

Claim 21 has been modified to correct this typographical error and to correctly specify the "second antenna circuit." Claim 27 has not been modified because claim 27 did not include the typographical error identified by the Examiner. However, claim 28 did include the typographical error. Therefore, claim 28 has been modified to correctly specify the "second antenna circuit."

Applicant respectfully submits that claims 21 and 28 now meet the requirements of 35 USC §112, second paragraph.

D. Rejection of Claims Under 35 USC 102

The Examiner has rejected independent claims 19 and 26, and dependent claims 20, 22 and 28 under 35 USC 102(b) as being anticipated by Aoki '430. Applicant respectfully disagrees, however, in order to expedite the prosecution of the present application, the Applicant has amended independent claim 19 and claim 26. More particularly, Applicant submits that the Examiner has failed to show that Aoki '430 discloses each element of the claims 19 and claim 26.

As the Federal Circuit stated in *W.L. Gore & Associates v. Garlock, Inc.*,¹ "anticipation requires the disclosure in single prior art reference of each element of the claim under consideration." Additionally, it is not enough that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*"²

In claim 19 and claim 26, the preamble makes reference to, "a wireless communication device". The wireless communication device is described in further detail in the specification and may include, "a handheld wireless

¹ *W.L. Gore & Associates V. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

² *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir.1983)) (emphasis added).

communications device, a mobile phone, a car phone, a cellular or a personal communications services (PCS) phone, a cordless phone, a laptop computer, or other computing device with a wireless modem, a pager or a personal digital assistant (PDA). The wireless device may be digital or analog or some combination thereof.” See Page 4: line 22 through Page 5: line 4. Each of these wireless communication devices is a *single* stand-alone device. Thus, to expedite the prosecution of this patent application, the Applicant has amended the preamble of independent claims 19 and 26 to refer to a, “*single* communication device.”

By contrast, each of the Aoki ‘430 embodiments teach at least two separate communication devices that have NOT been integrated into a single communications device. Additionally, Aoki ‘430 does not suggest or teach a motivation to combine these separate communications devices into a single device. For example, in the first and second embodiments depicted in FIG. 1 and FIG. 4, respectively, the transceiver unit 3 and 3A is separate from the handset 4. Each of the remaining embodiments reflect two physically separate communication devices in which at least one transceiver is in communication with a separate handset.

Regarding claim 19, the *single* wireless communication device includes yet another structural limitation that has not been recognized by the Examiner. The structural limitation is, “a processor coupled to the first antenna circuit and to the second antenna circuit.” Aoki ‘430 does NOT teach a processor that is coupled to the first antenna circuit and to the second antenna circuit. Instead each of the Aoki ‘430 embodiments teach at least two controllers, in which each

controller is associated with each transceiver. None of the Aoki '430 embodiments teach a single "controller" or "processor" that is coupled to the first antenna circuit and to the second antenna circuit as described in the claims.

Furthermore, the Examiner's remaining references Standke et al., U.S. Patent No. 6,694,150 (Standke '150) and Burdick et al., U.S. Patent No. 6,424,820 (Burdick '820) does not describe or suggest the structural limitations described above.

Therefore, a single communications device having a processor coupled to a first antenna circuit and a second antenna circuit, which described in claim 19, is not described or even suggested by Aoki '430, Standke '150 and Burdick '820.

Regarding claim 26, the Applicant has amended the preamble of claim 26 to include "having a processor" in the "single wireless communication device." In so doing, the Applicant has provided a structural limitation that is neither described or suggested by Aoki '430, Standke '150 and Burdick '820.

Regarding claims 20 and 26, the Examiner states that Aoki '430 discloses handoff type communications. However, as stated above Aoki teaches two controllers 16 and 9 performing this handoff function in col. 20, line 1-30. A processor housed with a single communications device is simply not taught or suggested by Aoki '430.

Regarding claims 22 and 28, the Examiner states that, "Aoki discloses the antenna system of claims 19 and 26, respectively, wherein the first communication signal and the second communication signal are combined for reception (col. 15, lines 25-34)." However, the section referenced by the Examiner in col. 15, lines 25-34 is NOT directed to combining the first

communication signal with a second communication signal for reception subject to a *single communication device having a processor*.

E. Rejection of Claims Under 35 USC 103

Regarding dependent claim 23 and renumbered claim 32 (note renumbered claim 32 is referred to as claim 29 by the Examiner), the Examiner rejected these claims as being unpatentable over Aoki '430 in view of Standke '150. In view of the amended independent claims 19 and 26, the Applicant contends that the 103 rejection is moot because the amended independent claims 19 and 26 are patently distinguishable from Aoki '430 and Standke '150.

However, for argument purposes only and to expedite the prosecution of this patent application, Standke '150 teaches a wireless telephone 102 having a variety of different transceiver and/or receivers. A signal separator 116 and 216 separates telephone signals and GPS and Bluetooth signals. The signal separator is NOT similar to Applicant's processor because the signal separator does not perform hand off functions or monitoring functions. Therefore, Standke '150 does NOT perform the functions of the processor that is claimed by the Applicant and/or suggest performing these functions.

Regarding claims 24, 25, 30 and 31, the Examiner rejected these claims as being unpatentable over Aoki, in view of Burdick '820. In view of the amended independent claims 19 and 26, the Applicant contends that the 103 rejection is moot because the amended independent claims 19 and 26 are patently distinguishable from Aoki '430 and Burdick '820.

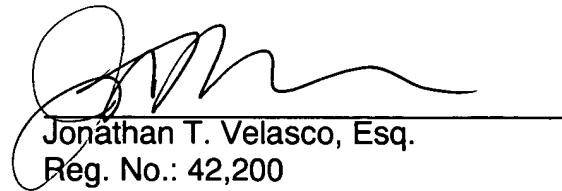
Arguendo, for claims 24 and 30, the Examiner refers to Burdick '820 at col. 51, line 61-65, which is under the col. 51 heading "Industrial Applications". Col. 51, line 61-65 describes the applications for a *short range* wireless communication system to interface with cell phones or cordless telephones and which is standards compliant. Applicant fails to see a suggestion to combine or modify the Aoki' 430 and Burdick '820 references to describe a *single communication device having a processor that is configured to hand off communications based on the first communication signal and the second communication signal.*

With respect to claims 25 and 30, the Examiner refers to Burdick's disclosure that the second antenna is disposed approximately orthogonal to the first antenna at col. 34, lines 1-15. Again, Applicant fails to see a suggestion where the references *describe a single communication device having a processor configured to perform hand off communications* as described above.

F. Conclusion

For all the foregoing reasons, withdrawal of the finality of the rejection of present Office Action and allowance of claims 19-32 pending in the present application are respectfully requested.

Respectfully Submitted,



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